

### **REMARKS**

The Applicant appreciates the courteous and complete examination of the application by the Examiner. In view of the foregoing amendments and the following remarks, a reconsideration of the instant application is respectfully requested.

In order to expedite the prosecution of this application claims 29, 34, 51 and 54 have been amended. Claims 29-54 are now in this application.

#### **Regarding the Specification**

The Applicant appreciates the opportunity to amend the specification. The specification has been amended to include a CROSS-REFERENCE TO RELATED APPLICATIONS section to comply with 37 CFR 1.77.

#### **Regarding the Drawings Objection**

The Examiner objected to the drawings under 37 CFR 1.83(a) for not showing every feature of the invention specified in the claims. In particular, "the means restricting inadvertent relative movement of the cutting means".

The Applicant respectfully points out that the claimed "means restricting inadvertent relative movement of the cutting means" is illustrated in the drawings, and is supported by the specification. Figure 9 illustrates a side wall 17 having a shoulder 41 located at the upper edge thereof, which restricts relative rotation of a blade carrier 49, support of which is found in paragraph [0071] of the present application. A cutting blade 31 is disposed on the end of the downwardly extending carrier 39, paragraph [0070]. Additionally, the shoulder 41 that stops relative movement of the cutting blade is further illustrated in Figures 10, 11, 12 and 14. Therefore, it can be appreciated that the "means restricting inadvertent relative movement of the cutting means" limitation is illustrated in Figures 9-12 and 14 of the present application and is sufficient enough to overcome this objection to the drawings.

#### **Regarding the Claim § 112 1<sup>st</sup> Paragraph Rejections**

The Examiner rejected claims 29-54 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In particular, the "means

restricting inadvertent relative movement of the cutting means" can not be determined with certainty. The Examiner states that the Applicant "can simply point out with specificity all of the corresponding structure in the specification in order to avoid this rejection."

The Applicant respectfully believes that the means restricting inadvertent relative movement of the cutting means limitations is sufficiently described in the specification and illustrated in the drawings. The present application describes the compartment 16 of the dispensing closure as having a side wall 17 featuring a shoulder 41 located at the upper edge thereof, which restricts relative rotation of a blade carrier 49. A cutting blade 31 is disposed on the end of the downwardly extending carrier 39. The shoulder 41 acts to stop the rotational movement of the cutting blade 31 cutting, support of which is located in paragraphs [0070], [0071] and [0077] of the present application. Furthermore, paragraph [0064] describes a "stop shoulder may be used so that the compartment 16 is able to be rotated relative to the cylindrical band 34 in one direction only, the shoulder preventing rotation in the opposite direction." Therefore, the shoulder 41 prevents the rotation of the compartment which houses the cutting blade "cutting means".

#### **Regarding the Claim § 112 2<sup>nd</sup> Paragraph Rejections**

The Examiner rejected to claims 29-54 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention. The Examiner specifically makes statements toward "the comments above relative to the noted "means"".

Independent claims 29, 51 and 54 have been amended to remove the "means" language directed toward the "restricting inadvertent relative movement" limitation and replace it with "a shoulder". Since the "means" language has been removed, it is believed that the shoulder limitation distinctly claims the subject matter and overcomes the Examiners rejection.

The Examiner rejects the term "engaging means" in claim 51 as being confusing and "not clear whether the "corresponding engaging means" is the same or different from the "engaging means" in line 3 of the claim."

The Applicant amended claims 51 to remove the language "corresponding" and replace it with "said". Claim 51 describes the "said engaging means" as the one "on said closure body". It can be appreciated that the claim 51 distinctly claims the engaging means as the one previously introduced on the body. Additionally, claims 34 and 54 have been amended to change the language "corresponding" and replace it with "a corresponding" thereby introducing the engaging means of the body and associating it with the engaging means of the rim located on the upper end of the compartment.

### **Regarding the Claim § 102 & 103 Rejections**

The Examiner rejected claims 29-54 under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morini (6,148,996), Morini (2005/0161348, Kasuya (2002/0096440) or Rizzardi (5,029,178). The Applicant believes that the Rizzardi reference was incorrectly indicated as (5,029,178) because patent number 5,029,178 is actually to Tarui, while patent number 5,029,718 is to Rizzardi.

During a telephone interview with the Examiner on June 18, 2008, the Examiner stated that the top wall of the compartment limitation in the independent claims are not specifically disclosed in the prior art references, but other top walls of other elements can be used as a top wall of the compartment. Additionally, the claimed shoulder restricting inadvertent relative movement of the cutting means limitations was discussed and the Examiner believes that this could be a patentable limitation, but additional review is required. The Applicant appreciates the time the Examiner took in discussing these aspects of the present application.

The Applicant respectfully points out that MPEP 2131 states "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As discussed herewithbelow, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest all the limitations in independent claims 29, 51 and 54.

*Regarding the 35 U.S.C. 102(b or e) rejections*

The Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a compartment having a top wall fixed to a side wall thereof, and in combination with "a shoulder for restricting inadvertent relative movement" of a cutting means, as described in independent claims 29, 51 and 54.

The '966 Morini reference describes a capsule (3) having a breakable bottom (4), a side wall and an open upper part (21) which receives a cutting element (11). The capsule (3) does not and can not have a top wall fixed to the side wall of the capsule, since a top wall will prevent the cutting element (11) from operating. The '966 Morini reference does not disclose, teach or suggest a structure of the shoulder which restricts inadvertent relative movement of a cutting means.

The 2005/0161348 Morini reference describes a reservoir (8) having a breakable bottom (8a), a side wall and an open upper part which receives a cutter (9). The reservoir (8) does not and can not have a top wall fixed to the side wall of the capsule, since a top wall will prevent the cutter (9) from operating. The '348 Morini reference does not disclose, teach or suggest a structure of the shoulder which restricts inadvertent relative movement of a cutting means.

The Kasuya reference describes a contents storage tube (24) having a thin bottom (26), a side wall and an open upper part which receives a cutting tube (120). The contents storage tube (24) does not and can not have a top wall fixed to the side wall of the capsule, since a top wall will prevent the cutting tube (120) from operating. The Kasuya reference does not disclose, teach or suggest the structure of a shoulder which restricts inadvertent relative movement of a cutting means.

The Rizzardi reference describes a reservoir (2) having a breakable bottom (3), a side wall and an open annular edge (6) which receives a cylindrical element (8) that ruptures the breakable bottom. The reservoir (2) does not and can not have a top wall fixed to the side wall of the capsule, since a top wall will prevent the cylindrical element (8) from operating. The Rizzardi reference does not disclose, teach or suggest a

structure of the shoulder which restricts inadvertent relative movement of a cutting means.

The Applicant requests that the Examiner reconsiders his rejections of the invention in view of the well established principle that small differences in a crowded art can constitute patentable improvement. See *In re Baum*, 51 USPQ 470 (CCPA 1941) and *In re Lange*, 126 USPQ 365 (CCPA 1960). In considering this principle, the Applicant would also request that the Examiner take note to the court decision which notes that "apparent simplicity has been held to furnish strong argument for patentability where, as here, a need has existed for a structure of the nature disclosed and claimed. The fact that a solution to a problem is simple, or appears to be simple when viewed in retrospect, does not mean that the solution was obvious when it was conceived." See *Ellipse corp. v. Ford Motor Co.*, 171 USPQ 513.

In regards to independent claim 54, since this claim is directed toward a method of using the identical apparatus and structure of claim 29, then claim 54 is believed to be in condition for allowance since the structure of claim 29 is believed to be patentably distinct.

Claims 30-50 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 29. Claims 52 and 53 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 51.

Regarding claims 33 and 34, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a relative rotation between the compartment and the body.

Regarding claim 34, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest an engaging means located on a rim on an upper end of the compartment, wherein the compartment engaging means engages a corresponding engaging means located on the body.

Regarding claim 36, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest the bottom wall of the compartment extending at an angle.

Regarding claim 37, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest the cutting means being carried on a flange extending radially inwardly from a lower edge portion of an inner wall of the body, wherein the flange is axially spaced from the bottom wall and a cutting knife extending from the flange toward the bottom wall, along with and in combination with its intervening claim 36. The Morini, Kasuya, and Rizzardi only and specifically describe a cutting element in the shape of a cylinder or tube that is received in the capsule or reservoir and which breaks the bottom wall by applying downward pressure. It can be appreciated that the present application claims substantially different structure from the prior art references.

Regarding claim 39, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest the side wall of the compartment being integral with the inner wall of the body, and in combination with a cylindrical band engaging the side wall and having a radially inwardly extending flange carrying the cutting means.

Regarding claim 40, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a cutting knife extending from the flange in an axial direction toward the top wall of the compartment, along with and in combination with its intervening claims 39 and 31.

Regarding claim 41, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest the cutting knife is housed in a pocket formed in the side wall of the compartment and which is released from the pocket so as to cut the bottom wall, along with and in combination with its intervening claims 40, 39 and 31.

Regarding claim 42, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a cutting knife carried on a flange extending radially inwardly from a lower edge of an inner wall of the body, with the cutting knife being housed in a pocket in the side wall of the compartment.

Regarding claim 45, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a cutting knife having at least two cutting edges extending at an acute angle to each other.

Regarding claim 49, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a top wall of the compartment having that is resiliently axially movable, and where an internal wall is connected to the top wall allowing the bottom wall to be cut, along with and in combination with its intervening claim 45.

Regarding claim 50, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest the compartment being separated into a plurality of parts, along with and in combination with its parent claim 29.

Regarding claim 52, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a cutting knife carried on a flange extending radially inwardly from a lower portion of the body, wherein the flange is axially spaced from the bottom wall of the compartment, and the cutting knife extending axially from the flange toward the bottom wall.

Regarding claim 53, the Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a cutting knife extending axially and inwardly from the top wall of the compartment and which is movable about the axis.

*Regarding the 35 U.S.C. 103(a) rejections*

The Applicant respectfully points out that to establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art, *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382,1385,165 USPQ 494,496 (CCPA 1970).

The Morini, Kasuya, and Rizzardi references do not disclose, teach or suggest a compartment having a top wall fixed to the side wall thereof, and in combination with "a

shoulder for restricting inadvertent relative movement" of a cutting means, as described in independent claims 29, 51 and 54. It can therefore be appreciated that the prior art references teach away from the claimed present invention because the cutting elements of the prior art references are received in the compartment through an opened top. As discussed above, the compartment in independent claims 29, 51 and 54 has a top wall, and any modification of the prior art reference to include a top wall in the compartment would change the principle operation of the prior art inventions.

Since the compartment top wall and the shoulder limitations are not disclosed, taught or suggested by the Morini, Kasuya, and Rizzardi references, then independent claims 29, 51 and 54 are believed to be patentably distinct therefrom. Claims 30-50 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 29. Claims 52 and 53 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 51.

The Applicant believes that it would not have been obvious by one skilled in the art to invent the present claimed invention, since the Morini, Kasuya, and Rizzardi references do not suggest, teach, or show any motivation to have a compartment including a top wall, in combination with a shoulder for restricting inadvertent relative movement of the cutting means. Thus, it can therefore be appreciated that these references are not a proper basis for the § 103 rejections. See e.g., *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999). Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Therefore, the combination of the Morini, Kasuya, and Rizzardi references do



not render the resultant combination obviousness since the Morini, Kasuya, and Rizzardi references do not suggest the desirability of the combination.

Additionally, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Since the Morini, Kasuya, and Rizzardi references do not disclose, teach, or suggest the compartment having a top wall, then the Examiner used a proposed modification of the prior art in the § 103 rejection of independent claims 29, 51 and 54. Since the Morini, Kasuya, and Rizzardi references do not disclose a compartment with a top wall, then any modification of the references would result in the cutting elements to not operate as described and specified in the references. It can therefore be appreciated that since the Examiner's proposed modifications of the Morini, Kasuya, and Rizzardi references do change the principle of operation of the prior art, then the Morini, Kasuya, and Rizzardi references are not sufficient to render the claims obvious.

However, as the Supreme Court recently explained "a patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S., 82 U.S.P.Q.2d 1385, 1396 (2007). Moreover, "[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.* (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)). "To facilitate review, this analysis should be made explicit." *Id.* Furthermore, "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning. See *Graham*, 383 U. S., at 36 (warning against a 'temptation to read into the prior art the teachings of the invention in issue' and instructing courts to 'guard against slipping into the use of hindsight' (quoting *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F. 2d 406, 412 (CA6 1964)))." *Id.* at, 82 U.S.Q.P.2d at 1397.

**Conclusion**

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicant is not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicant reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicant has made any disclaimers or disavowals of any subject matter supported by the present application.

Applicant has endeavored to address all of the Examiner's concerns as expressed in the Office Action. Accordingly, amendments to the claims, the reasons therefor, and arguments in support of patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above-remarks are made in order to improve the clarity of claim language, to correct grammatical mistakes or ambiguities, and to otherwise improve the clarity of the claims to particularly and distinctly point out the invention to those of skill in the art. Finally, Applicant submits that the claim limitations above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art.

With the above amendments being fully responsive to all outstanding rejections and formal requirements, it is respectfully submitted that the claims are now in condition for allowance, and a notice to that effect is earnestly solicited. Should the Examiner feel that there are further issues which might be resolved by means of telephone interview, the Examiner is cordially invited to telephone the undersigned at (403) 444-5695, or email at davidguerra@internationalpatentgroup.com

No additional fee is due.

Respectfully Submitted,

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